

### **REMARKS**

The claims currently pending in the application are claims 71-74, 76-87, 97-99, 102-104, 107, 108, 110, 113-115, 117, 118 and 121-124. Claims 1-70, 75 and 101 have been previously cancelled pursuant to the Preliminary Amendment and Amendment A. Claim 105 was cancelled pursuant to Amendment B. Claims 89-96, 100, 106, 109, 111, 112, 116, 119 and 120 are cancelled pursuant to the present Amendment C. Claims 121-124 have been added pursuant to the present Amendment C.

### **Drawings**

It is noted that Examiner has objected to the figures submitted beyond figure 15 bas these figures have not been enumerated with proper figure numbers. Applicants have cancelled the figures beyond figure 15 and have amended the specification to reflect this change.

### **Claim Rejections Under 35 USC § 112**

It is further noted that Examiner has rejected claim 72 under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Examiner states that claim 72 refers to "the source" but does not specify if "the source" refers to "a display device", "a radio signal source" or a "yet unclaimed third source of promotional opportunities". Applicants have amended claim 72 to reflect that the source is a source of the video signals.

### Claim Rejections Under 35 USC § 102

Claims 111, 112, and 120 have been rejected under 35 USC §102(b) as being unpatentable over *Nemirofsky* and claim 76 has been rejected over *Von Kohorn*.

Applicant has cancelled 111, 112, and 120 pursuant to the present Amendment C.

With respect to claim 76, the Examiner contends that the *Von Kohorn* reference discloses a hand-held device for a user to interact with a source of auxiliary data and providing one or more promotional opportunities pre-stored by a sponsor on the hand-held device in conjunction with material presented by the source from the reception of auxiliary data from the source, the hand-held device comprising a receiver disposed on the hand-held device for receiving auxiliary data from the source during presentation of the material; and a central processing unit (CPU) and other circuitry disposed on the hand-held device and coupled to the receiver which compares the auxiliary data received against pre-stored data that triggers one or more pre-stored promotional opportunities for a user of the hand-held device.

Applicants respectfully submit that claim 76 is neither anticipated by nor rendered obvious over *Von Kohorn*.

With respect to independent claim 76, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Von Kohorn*. Specifically, the device of *Von Kohorn* allows the user to define the parameters (i.e., discounts for a desired product or groups of products) by which the device will receive information. (See Col 1 lines 10-13 and Col 4 lines 8-13.) Accordingly under *Von Kohorn*, the user, not the sponsor, programs and stores desired match information for the device. (See Col 4 lines 8-13, Col 7 lines 30-33, Col 11 lines 35-42 and lines 54-57 and Col 14 lines 12-15.) In stark contrast, the hand-held device of Applicants invention has the one or more promotional opportunities and associated preprogrammed data defined on the hand-held device by the sponsor (i.e., preconfigured) prior to

use of the device by the user. (See page 8 lines 8-14, page 15 lines 20-23, page 16 lines 7-30 and page 20 lines 24-29.)

Applicants have amended independent claim 76 to clarify that the promotional opportunities and associated preprogrammed data are preconfigured by the sponsor prior to use of the hand-held device by the user. Thus, claims 76 is submitted to be patentably novel over *Von Kohorn*.

Accordingly, it is respectfully submitted that this rejection under §102 should be withdrawn as to claim 76.

#### **Claim Rejections Under 35 USC § 103**

Claims 71-74, 103 and 113 have been rejected under 35 USC §103(a) as being unpatentable over *Nemirofsky* in view of *Martin*, claims 77, 78, 79, 104 and 114 have been rejected over *Von Kohorn* in view of *Nemirofsky*, claim 80 has been rejected in view of *Von Kohorn* and *Nemirofsky* in view of *Martin*, claim 110 has been rejected in view of *Von Kohorn* and *Nemirofsky* in view of *Walker*, claims 81-83 and 115 have been rejected over *Nemirofsky* in view of *Walker*, claim 84 has been rejected over *Nemirofsky* and *Walker* in view of *Martin*, claims 85 and 88 have been rejected over *Nemirofsky* and *Walker* in view of *Bullock*, claims 86 and 87 have been rejected over *Nemirofsky*, *Walker* and *Bullock* in view of *Brooks*, claims 89-93, 95, 106 and 116 have been rejected over *Nemirofsky* in view of *Laor*, claim 94 has been rejected over *Nemirofsky* and *Laor* in view of *Martin*, claim 96 has been rejected over *Nemirofsky* and *Laor* in view of *Robb*, claims 97, 107 and 117 have been rejected over *Nemirofsky* in view of *Dominguez* and *Martin*, claims 98, 99 and 102, 108 and 118 have been rejected over *Nemirofsky* in view of *Boggs* and claims 100, 109 and 119 have been rejected over *Nemirofsky* in view of *Wagner*.

Referring to claims 71-74, 103 and 113, the Examiner contends that the *Nemirofsky* reference discloses a hand-held device for receiving promotional opportunities from a display device and a radio signal source, the hand-held device comprising a photodetector, a CPU and a decoding means. The Examiner contends that the *Martin* reference discloses a receiver with a receiver radio frequency receiver and a photodetector.

Applicants respectfully submit that claims 71-74, 103 and 113 are not rendered obvious by *Nemirofsky* in view of *Martin*.

With respect to independent claim 71, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* in view of *Martin*. Specifically, a satellite receiver (12) of *Martin* that has both RF antenna (20) and IR sensor (22) "coordinates command signals from multiple sources" and provides output (i.e., control signals) to television monitor (14). (See Fig. 1, Col 1 lines 10-13 and lines 53-56 and Col 2 line 67 to Col 3 line 22.) *Martin* teaches away from the satellite receiver being portable because it is directly connected to the television monitor and moving the receiver away from the monitor is inapposite to the purpose of the invention (i.e., coordinating command signals that are provided to a television). (See Fig. 1 and Col 1 lines 10-13.) The *Martin* reference contains no suggestion that the satellite receiver or the television is hand-held or even mobile. In fact, someone skilled in the art would not have been motivated to make the satellite receiver portable because of the availability of remote controls that are portable and control the stationary satellite receiver.

The hand-held devices of *Martin* are the remote control units (16 and 18), which send control signals to the satellite receiver. (See Fig. 1 and Col 3 lines 6-8.) The control signals received by the satellite receiver are not auxiliary data nor are they used to provide promotional opportunities or to otherwise encourage a user to behave in a certain manner. Rather, the control signals are primary signals in that they are used to control a variety of system functions of the

television such as changing channels and volume control. (See Col 1 lines 15-22 and Col 2 lines 10-12.) Someone skilled in the art would not be motivated under the *Martin* reference to modulate these control signals within a video signal, because it produce the heinous result of allowing a video broadcaster to control the volume and channel on the television. In addition, *Nemirofsky* does not disclose or suggest the use of control signals, but rather provides “a method of sending data transmission along with a standard television signal in the form of changing light pulses.” (See Col 3 lines 49-51.)

*Martin* also does not teach the receipt of RF and IR by the same hand-held device, as the remote control units transmit control signals via IR and RF. (See Col 3 lines 6-8.) In contrast, Applicants hand-held device receives auxiliary data by both photodetector and RF. (See page 38 line 9 – page 39 line 15.) There is therefore no suggestion to modify the references as claimed by the Examiner. In consideration of all the foregoing reasons, the skilled artisan would not be lead to combine *Nemirofsky* and *Martin* references to provide the presently claimed combination.

Applicants have amended independent claim 71 to clarify that the photodetector disposed on the hand-held device receives video signals containing auxiliary data from the display device. Thus, claims 71-74, 103 and 113 are submitted to be patentably unobvious over the combination of *Nemirofsky* and *Martin*.

Referring to dependent claims 77, 78, 79, 104 and 114, the Examiner contends that the *Von Kohorn* reference discloses the hand-held device of claim 76. The Examiner also contends that the *Nemirofsky* reference discloses receiving auxiliary data directly from a display device using a photodetector wherein the auxiliary data is subliminally modulated within an active portion of the video signals in a substantially invisible way.

Applicants respectfully submit that claims 77, 78, 79, 104 and 114 are not rendered obvious by *Von Kohorn* in view of *Nemirofsky*.

The combination of the present references still fails to show Applicants' invention as obvious since it fails to teach a claimed featured critical as described with respect to claim 76 above.

Notwithstanding the foregoing, the apparatus of the *Von Kohorn* reference teaches away from the *Nemirofsky* reference and the claimed device in that the user enters the product information to preprogram the device to obtain information and coupons relating to the user's future purchase. (See Col 1 lines 40-45 and 62-66 and Col 4 lines 8-13 and lines 27-37.) Thereafter, the products are presented to the user on the display device and the user is provided with an opportunity to download these opportunities. (See Col 7 lines 51-53.) In contrast, the card of *Nemirofsky* receives promotion data encoded in a television directly from a display device, and no information is preprogrammed on the device. (See Abstract.)

The interactivity of a user orienting a card towards a display device for watching specifically enhanced programming is a primary object of *Nemirofsky*. (See Col 1 lines 5-10 and Col 5 lines 25-31.) The device of *Von Kohorn* teaches away from such interactivity, as users of the preferred embodiment manually enter product information and verification data into the unit to generate a coupon instead of watching the programming content. (See Col 7 lines 2-5 and lines 30-33.) In an additional embodiment, the user of the *Von Kohorn* device may configure the device so as to record live signals by the user entering into the device desired products. (See Col 11 lines 25-57.) A data comparison device of the device signals a controller to record product information signals "without the viewer having to watch live product information signal broadcasts, or ever be home." (See Col 11 lines 48-57.)

The *Von Kohorn* device is not portable or available for in-store redemption; rather it provides tokens or coupons with value to a user that may be redeemed with paper coupons or magnetic cards. (See Col 8 lines 5-18.) Unlike the card of *Nemirofsky*, tokens or coupons under

the *Von Kohorn* reference are not directly redeemable with the device that receives the video signals. In fact, there is no suggestion to modify the references as claimed by the Examiner. *Von Kohorn* teaches away from *Nemirofsky* because the only device of *Von Kohorn* that directly receives the video signal (i.e. instead of a user manually entering product information) is a video recorder machine (i.e., VCR) that has a channel display (82), channel selector keys (88), sensor (90) to be used with a remote control, and various controls and buttons for recording video signals. (See Col 9 lines 54-62 and Fig. 6.) In addition, the device operates directly with the television by directly receiving video signals on its device via transmission cable 76 from a broadcast means and transmitting video signals from the device to the television via transmission cable 77. (See Col 9 lines 49-54.) Finally, the VCR functionality of the device is specifically set forth in the specification. (See Col 10 lines 10-19.) At the time of the Applicants' invention, it was not (and still is not) possible to provide video recorder technology in a hand-held device that received and recorded broadcast video signals by a radio frequency receiver or photodetector that were of suitably quality to reproduce on a television. Accordingly, the skilled artisan would not be lead to combine *Von Kohorn* and *Nemirofsky* references to provide the presently claimed combination.

Dependent claims 77, 78, 79, 104 and 114 are therefore submitted to be patentably unobvious over *Von Kohorn* in view of *Nemirofsky*.

With respect to claim 80, the Examiner contends that *Von Kohorn* and *Nemirofsky* disclose the hand-held device of claim 77. The Examiner contends that *Martin* teaches a receiver possessing a photodetector and a radio frequency receiver.

Applicants respectfully submit that claim 80 is not rendered obvious by *Von Kohorn* and *Nemirofsky* in further view of *Martin*.

Specifically, Applicants refer to the aforementioned comments regarding *Nemirofsky* and *Martin* to claim 71 and *Von Kohorn* and *Nemirofsky* with respect to claim 77.

Claim 80 is therefore submitted to be patentably unobvious over the combination of *Von Kohorn* and *Nemirofsky* in further view of *Martin*.

With respect to claims 81-83 and 115, the Examiner contends that the *Nemirofsky* discloses a hand-held device that receives promotional opportunities from a source, the hand-held device comprising a receiver, a CPU, and a nonalphanumeric display. The Examiner further contends that *Walker* teaches a reward system wherein the rewards are assigned based on met thresholds, or tiers, meaning that each successive reward level is relative to the previous reward level, with progressive benefits to the user as each reward tier is met in turn.

Applicants respectfully submit that claims 81-83 and 115 are not rendered obvious by *Nemirofsky* in further view of *Walker*.

With respect to independent claim 81, the LCD of *Nemirofsky* reference is limited to displaying alpha-numeric characters and bar codes by use of a graphic display or formed character display. (See Col 7 lines 53-56 and Col 10 lines 38-45.) There is no suggestion in *Nemirofsky* that the LCD may be used to present nonalphanumeric indications, such as lights and LEDs as disclosed in the Applicants' device, as the LCD of *Nemirofsky* teaches away from the LCD being substituted for lights or LEDs because it "absorbs or defuses light to produce a black on white display, with a light reflecting or refracting surface." (See Col 8 lines 22-25.)

The tier rules of the *Walker* reference do not provide successive promotional opportunities as with the Applicants' hand-held device. Rather, the tier rules relate to "disproportionately increasing redemption values as reward levels increase beyond various threshold levels or tiers." (See Col 9 lines 58-61.) The reward levels are determined based on the current transaction and which account members are present at the store and then calculated



by a series of adjustments each time a reward member (or members) is at the store. (See Figs. 2, 6A and 6B and Col 12 lines 27-34 and Col 13 line 62 – Col 14 line 54.) In addition, the reward is allocated immediately after calculating the reward level. (See Fig. 2, Col 4 lines 30-33, Col 12 lines 48.) In contrast, the successive promotional opportunities offered to a user of the invention as set forth in claim 81 are determined prior to providing the hand-held device to the user. (See page 15 line 30 – page 16 line 3.) Applicants invention does not contemplate real-time reward allocation because users of Applicants' hand-held device need incentive to watch television multiple times to obtain a tangible reward (or possibility of a tangible reward). upon a single redemption of the hand-held device, and therefore do not have incentive to repeatedly take their device and fellow shoppers to a store and use the device while at the store. Moreover, the hand-held device of *Walker* rewards shoppers with specific behavior such as frequency of shopping and number of persons present while shopping by use of threshold levels or tiers, while Applicants invention rewards television viewers with specific behavior such as watching four quarters in a football game.

The combination of *Walker* and *Nemirofsky* therefore does not render the invention as set forth in claim 81 as obvious because the references fail to disclose a non-alphanumeric display and successive promotional opportunities as claimed with the present invention. In addition, someone skilled in the art would not be motivated to combine *Walker* and *Nemirofsky*, and there is no suggestion for someone skilled in the art to do so.

Claim 81 has been further amended to clarify Applicants invention. Independent claim 81 and dependent claims 82, 83 and 115 are therefore submitted to be patentably unobvious over the combination of *Nemirofsky* in view of *Walker*.

As discussed above, the Examiner contends that *Von Kohorn* and *Nemirofsky* disclose the hand-held device of claim 104. With respect to dependent claim 110, the Examiner contends

that *Walker* teaches a reward system wherein the rewards are assigned based on met threshold levels, or tiers.

Applicants submit that claim 110 is not rendered obvious by *Von Kohorn* and *Nemirofsky* in further view of *Walker*.

With respect to claim 110, Applicants submit that the subject matter claimed therein patentability distinguishes over *Von Kohorn* and *Nemirofsky* in further view of *Walker*. Specifically, Applicants refer to the aforementioned comments regarding *Von Kohorn* and *Nemirofsky* to claim 77 and *Nemirofsky* and *Walker* with respect to claim 81.

Claim 110 is therefore submitted to patentably nonobvious over the combination of *Von Kohorn* and *Nemirofsky* in further view of *Walker*.

As discussed above, the Examiner contends that *Nemirofsky* and *Walker* disclose the hand-held device of independent claim 81. With respect to dependent claim 84, the Examiner contends that *Martin* teaches a receiver which includes a radio frequency receiver and a photodetector.

Applicants submit that claim 84 is not rendered obvious by *Nemirofsky* and *Walker* in view of *Martin*.

With respect to dependent claim 84, Applicants submit that the subject matter claimed therein patentability distinguishes over *Nemirofsky* and *Walker* in view of *Martin*. Specifically, Applicants refer to the aforementioned comments regarding *Nemirofsky* and *Martin* with respect to claim 71 and *Nemirofsky* and *Walker* with respect to claim 81.

Claim 84 is therefore submitted to be patentably unobvious over the combination of *Nemirofsky* and *Walker* in view of *Martin*.

As discussed above, the Examiner contends that *Nemirofsky* and *Walker* disclose the hand-held device of independent claim 81. With respect to dependent claim 85, the Examiner

contends that *Bullock* teaches a display comprising separate indicator LEDs, one for each type or class of promotional opportunities or auxiliary data received by the device, indicating to the user which promotional opportunities are available.

Applicants submit that claim 85 is not rendered obvious by *Nemirofsky* and *Walker* in view of *Bullock*.

With respect to dependent claim 85, Applicants submit that the subject matter claimed therein patentability distinguishes over *Nemirofsky* and *Walker* in view of *Bullock*. The device in *Bullock* utilizes lights and LEDs to indicate the type or class of coupon data that is being downloaded to the device so that the user can, after downloading, decide whether to print and therefore use the coupon. (See Col 7 lines 25-39.) In contrast, the claimed device utilizes multiple LEDs to demonstrate relative levels of promotional opportunities, such as by lighting multiple LEDs a user of the device will receive a larger prize. (See page 15 lines 20-27 for support.) In addition, unlike the device in *Bullock* where a single LED is lit at a time relative to the content on the television, multiple LEDs on the claimed invention may become lit when the user has earned such lights based on continuing participation or winning a larger prize.

The *Bullock* reference further teaches away from the *Nemirofsky* reference because the device in *Bullock* requires no user interaction to download promotional opportunities from the source; rather, user interaction is only required to printout the coupons from the device. In *Nemirofsky*, the user selectively receives promotion data depending on the content displayed on the television. (See Abstract and Col 3 lines 49-57.) Thus, there would be no motivation in *Nemirofsky* to encourage relative behavior relating to award levels.

In this connection, the observation is appropriate of the Court of Customs and Patent Appeals in the case *In re Shaffer*, 108 USPQ 326, 328-329 (1956), wherein it stated at page 329:

... it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be

viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined.

Applicant submits that it is only by hindsight that Examiner is motivated to find and combine the above references to attempt to arrive at the claimed invention. In *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990), the Federal Circuit found that "...it is insufficient that prior art shows similar components, unless it also contains some teaching, suggestion, or incentive for arriving at the claimed structure." Applicant submits that no teaching, suggestion, or incentive has been shown, and that the teaching suggested by the Examiner is unwarranted in view of the references.

The Federal Circuit recently made clear that the identification of prior art statements that appear to suggest a claimed limitation does not establish a prima face case of obviousness, without a finding as to the *specific understanding or principle within the knowledge of the skilled artisan* that would have motivated one with no knowledge of the intention to make the claimed combination. *In re Kotzab*, 55 USPQ 1313 (Fed. Cir. 2000).

Claim 85 is therefore submitted to be patentably unobvious over the combination of *Nemirofsky* and *Walker* in view of *Bullock*.

As discussed above, the Examiner contends that *Nemirofsky*, *Walker* and *Bullock* disclose the hand-held device of dependent claim 85. With respect to dependent claim 86, the Examiner contends that *Brooks* discloses using a plurality of LEDs of different colors, in order to provided color-coded messages as indicators. With respect to dependent claim 87, the Examiner contends that *Brooks* discloses the use of a plurality of LEDs to form a pattern indicative of receiving auxiliary data.

Applicants submit that claims 86 and 87 are not rendered obvious by *Nemirofsky*, *Walker* and *Bullock* in view of *Brooks*. Specifically, Applicants refer to the aforementioned comments regarding *Nemirofsky*, *Walker*, and *Bullock* with respect to claim 85. With respect to *Brooks*, the LEDs used in *Brooks* are used to indicate the mode of operation of the device, battery strength or proper operation of the device. (See Col 1 lines 6-7, Col 7 line 49 – Col 8 line 4 and Col 4 lines 15-22.) In contrast, the claimed device utilizes the LEDs to act as the indication display for displaying receipt of auxiliary data relating to relative successive promotional opportunities, and not for indicating whether the device is properly operating. (See page 15 line 20 – page 16 line 29 for support.)

In Examiner's Office Action, the Examiner has modified *Brooks* to show "the use of varied LED configurations to convey information regarding downloaded information." However, there is no teaching in *Brooks* or suggested therein in this regard, as the device in *Brooks* constantly receives internal sensory information from a pressure detector, a motion detector, and a temperature sensor that monitors use of the device. (See Col 6 line 52 – Col 7 line 32). It is this sensory information regarding proper use which is indicated by the LEDs. (See Col 7 lines 33-38.)

The device in *Brooks* measures a user's exposure to programming material, and provides benefits to the user of the device based upon proper and continuance usage. (See Abstract and Col 1 line 63 - Col 2 line 3 and Col 4 lines 62-64.) Accordingly, the device in *Brooks* promotes compliance with predescribed procedures for use of the device including carrying the device and docking it instead of encouraging user interaction with the device. (See Col 1 line 63 – Col 2 line 7.) In contrast, the device in *Bullock* rewards the user with the capability of selectively printing coupons that have been downloaded to the device. (See Col 3 lines 19-27.) In *Nemirofsky*, the user selectively receives promotion data depending on the content displayed on

the television. (See Abstract and Col 3 lines 49-57.) Accordingly, *Brooks* teaches away for providing rewards for user interaction, and instead teaches providing rewards for user compliance. Accordingly, someone skilled in the art would not find a suggestion or be motivated to combine the *Brooks* reference with the teachings of *Nemirofsky*, *Walker* and *Bullock* to provide the presently claimed combination.

With respect to dependent claims 86 and 87, Applicants submit that the subject matter claimed therein patentability distinguishes over *Nemirofsky*, *Walker* and *Bullock* in view of *Brooks*.

With respect to claims 97, 107 and 117, the Examiner contends that the *Nemirofsky* discloses a method of interactive advertising in connection with a user's observance of events comprising transmitting auxiliary data related to such events, providing means for receiving the auxiliary data for the user of a hand-held device, and providing a benefit to the user of the hand-held device for selectively receiving the promotional opportunities. The Examiner contends that *Dominguez* discloses a method utilizing a hand-held device for receiving auxiliary data from a radio signal source which can be used while the user attends a special event. The Examiner contends that *Martin* teaches a receiver which includes a radio frequency receiver and a photodetector.

Applicants respectfully submit that claims 97, 107 and 117 are not rendered obvious by *Nemirofsky* and *Dominguez* in further view of *Martin*.

With respect to independent claim 97, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* and *Dominguez* in further view of *Martin*. Specifically, Applicants refer to the aforementioned comments regarding *Nemirofsky* and *Martin* with respect to claim 71.

The device in *Dominguez* is a radio monitor that receives radio frequencies that are directly heard by the user of the hand-held device. (See Abstract, Col 1 lines 12-20, Col 2 lines 9-12 and Col 2 lines 43-63.) In contrast, the radio frequency signals of the *Martin* reference are used to accept a command signal to control system functions (e.g. changing volume or channels) on a receiver. (See Col 1 lines 17-19 and Col 2 lines 13-32.) Not only does the *Dominguez* reference fail to teach the transmission or reception of auxiliary data, there is no intention or possible use described for the radio monitor receive to auxiliary data. Moreover, the *Dominguez* reference is in a different, unrelated industry for which someone skilled in the art would not look for teachings. Consequently, there would be no motivation to combine *Dominguez* with *Nemirofsky* and *Martin*, and the skilled artisan would not be lead to combine the cited references to provide the presently claimed combination.

With respect to claim 98, 99 and 102, 108 and 118 the Examiner contends that the *Nemirofsky* reference discloses a method of interactive advertising and promotion relative to material presented by a display device comprising transmitting auxiliary data during presentation of the material, when the auxiliary data is associated with a sponsor of the material and carries promotional opportunities, providing means for receiving the auxiliary data for users of a hand-held device while they view the events on a display device, and providing a benefit to the user of the hand-held device for selectively receiving the promotional opportunities, the hand-held device being capable of retaining indication of having received the promotional opportunities, this indication comprises a means for presenting to the user the promotional opportunities received by means of the auxiliary data.

The Examiner contends that the *Boggs* reference discloses a toy camera that resembles a snap-shot camera and a simulated lens which simulates a real camera for the advantage of providing a familiar mechanism to simulate an image pickup device.

Applicants respectfully submit that claims 98, 99 and 102, 108 and 118 are not rendered obvious by *Nemirofsky* in view of *Boggs*.

With respect to independent claims 98 and 102, Applicants respectfully submit that the subject matter claimed therein patentably distinguishes over *Nemirofsky* in view of *Boggs*. Specifically, the device of *Boggs* is a toy camera that does not receive any signals beyond standard light, and is therefore no more pertinent than any other nonfunctioning toy. (See Abstract, Col 1 lines 5-7, and Col 1 line 31 – Col 2 line 12.) *Boggs* teaches away from receiving video signals as in *Nemirofsky* because light is reproduced from the device upon user actuation. (See Col 3 lines 37-43.) In contrast, *Nemirofsky* captures video signals (i.e., light) with auxiliary data during activation. (See Col 5 lines 39-50.) A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In re Gurley, 27 F.3d 551, 553, (Fed. Cir. 1994). Thus, since *Boggs* teaches light reproduction which would wash out any possible reception of a video signal, the disclosure of *Boggs* does not provide a productive teaching in view of *Nemirofsky*.

The toy flash camera of *Boggs* is not card-like in that it has a camera body comprised of a substantially rectangular body, lens unit and a flash body, where the lens unit and flash body extend from the toy flash camera. (See Col 1 lines 32-42 and Col 2 lines 42-50.) *Nemirofsky* teaches away from *Boggs* in that the dimensions of the card of *Nemirofsky* is the size of a credit card and "may be somewhat thicker to protect the Liquid Crystal Display from flexing and to contain a battery." (See Col 6 lines 1-3 and Col 7 lines 49-53.) A person of ordinary skill in the art would not be motivated to increase the size of the card in *Nemirofsky* to accommodate a suggestion for the manner in which the device should be used because portability (i.e., taking the card to a point of purchase store) was an essential part of *Nemirofsky*. (See Col 5 lines 45-50, Col 6 lines 1-3 and Col 7 lines 42-49.) In contrast to *Nemirofsky* and *Boggs*, the invention of



claims 98 and 102 has a specific teaching regarding facsimile representation of gaming devices.  
(See page 16-27.)

The device of *Boggs* is merely a toy camera that is intended to be used by children to simulate the taking of pictures with a flash. (See Col 1 lines 18-29.) There is no teaching in *Boggs* to accommodate the reception of video signals and/or auxiliary data. The device of *Nemirofsky* is a TV card that resembles a credit card in size and dimensions. (See Col 7 lines 50-53.) There is no teaching in *Nemirofsky* to modify the dimensions or appearance of the device to resemble a snap shot camera or any other device that simulates use of the device. (See Col 6 lines 1-3.) "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. [The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Here, the Examiner has not meet his burden to make a proper showing by merely stating the unsubstantiated statement that "the only modification made in view of *Boggs* is shaping a device which is not a camera to like a camera for user enjoyment."

Accordingly, it is respectfully submitted that this rejection under §103 should be withdrawn as to claims 71, 77-81, 97, 98, 102, 104, and 114. Claims 72-74, 103 and 113 depend from claim 71, claim 110 depends from claim 104, claims 82-87 and 115 depend from claim 81, all of which add further structural elements thereto. Claims 107 and 117 depend from claim 97, claims 99, 108 and 118 adding further method limitations thereto. The rejections should be withdrawn from these claims as well.

Applicants have cancelled claims 88-96, 100, 106, 109, 111, 112, 116, 119, and 120 so as to further clarify the scope of the present invention.

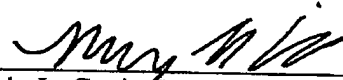
Applicants have added claims 122-124 to provide alternate recitation for features specified in the specification.

Applicants have made a sincere and earnest effort to advance the prosecution of this case to allowance. Such action is now believed to be in order. Should there be any remaining informalities or issues, it is submitted that this may be handled by Examiner's Amendment or that the Examiner should accordingly initiate a telephone conference with the Applicants' under signed attorney Randy L. Canis. Applicants stand ready to cooperate as fully as possible to advance the prosecution of this case to allowance.

Respectfully submitted,

10/6/04

Date



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